

REMARKS

This is a full and timely response to the outstanding final Office Action mailed June 19, 2007 (Paper No. **Error! Reference source not found.**). Upon entry of this response, claims 117-128 and 130-164 are pending in the application. In this response, claims 117-118, 121, 123, 127, 138, and 153 have been amended, claim 164 has been added, and claims 1-116 and 129 have been cancelled. Applicant respectfully requests that the amendments be filed herewith be entered and request that there be reconsideration of all pending claims.

I. Rejection of Claims 117-129, 132-146, and 149-160 under 35 U.S.C. §102

Claims 117-129, 132-146, and 149-160 have been rejected under §102(b) as allegedly anticipated by *Nishikawa et al.* (U.S. 6,481,010). Applicant respectfully traverses this rejection. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

A. Independent Claim 117

1) *Nishikawa et al.* does not disclose “enabling a user to record a first set of media programs in a first digital storage device associated with a personal video recorder (PVR); storing media information corresponding to the first set of media programs in the first digital storage device”

The Office Action (p. 4) indicates that this “enabling” feature is disclosed in *Nishikawa et al.* Col. 2, lines 6-27, Col. 5, lines 49-65, and Col. 6, lines 14-43, and that this “storing” feature is disclosed in *Nishikawa et al.* Col. 9, line 53-Col. 10, line 35 and Col. 13, lines 19-45. Since the portions of *Nishikawa et al.* which are alleged to teach “enabling a user to record” describe the recording as recording to a VCR, Applicants must infer that the Office Action is alleging that the recited “first storage device” corresponds to a VCR.

Applicants will assume, for the sake of argument, that *Nishikawa et al.* teaches enabling a user to record programs in a VCR. Applicants will further assume, for the sake of argument, that *Nishikawa et al.* teaches storing media information corresponding to recorded programs. Even so, *Nishikawa et al.* does not teach that the VCR “stor[es] media information corresponding to the first set of media programs **in the first storage device**”, where the first storage device corresponds to the VCR, as implied by the Office Action. Applicants have reviewed the portions of *Nishikawa et al.* which the Office Action alleges as teaching this “storing” feature, namely Col. 9, line 53-Col. 10, line 35 and Col. 13, lines 19-45, and will now explain why none of those portions teach the recited “storing” feature.

The first portion of *Nishikawa et al.* that is cited by the Office Action (Col. 9, line 53-Col. 10, line 35) describes data that is stored “in a portion of HDD 228 and/or flash memory 230”. The Office Action rejection implies that - and is internally inconsistent unless - the first storage device corresponds to a VCR. However, neither a hard disk drive (HDD) nor flash memory is a VCR. For at least this reason, *Nishikawa et al.* does not teach, disclose, or suggest “storing media information corresponding to the first set of media programs **in the first storage device**”.

The second portion of *Nishikawa et al.* that is cited by the Office Action (Col. 13, lines 19-45) describes a TV Planner screen 632 which displays programs selected for purchase alongside a “Purchase” icon 634, and programs selected for recording alongside a “Record” icon 638. This cited portion also describes presenting a list of purchased programs after the user selects a “Review Purchases” icon 614, and presenting a list of programs selected to view or record after the user selects a “Timer & Recording” icon 612. Applicants will assume, for the sake of argument, that these teachings also imply **storage** of information about purchased programs and information about programs selected to view or record. Even so, *Nishikawa et al.* does not teach, expressly or impliedly, that such program information is stored on the VCR. This particular cited portion of *Nishikawa et al.* is silent as to where such program information is stored. Furthermore, Applicants submit that a person of ordinary skill in the art would understand that program information is stored on one of the digital storage devices included in the digital satellite system (DSS) receiver (e.g., hard disk, flash memory) rather than the VCR, which is an analog storage device. Yet, as pointed out earlier, the Office Action rejection implies that- and is internally inconsistent unless - the first storage device corresponds to a VCR.

Furthermore, claim 117 has been amended to recite “enabling a user to record a first set of media programs in a first digital storage device associated with a personal video recorder (PVR)”. In addition to the reasons discussed above, amended claims 117 is also patentable over *Nishikawa et al.* because the VCR in *Nishikawa et al.* is an analog storage device rather than a digital storage device. For at least these reasons, the rejection of claim 117 should be withdrawn.

2) *Nishikawa et al.* does not disclose “responsive to the user entering a search term, searching the first and second storage devices for media information having a high level of correlation with the search term”

The Office Action (pp. 4-5) indicates that this “searching” feature is disclosed in *Nishikawa et al.* Col. 3, line 61-Col. 4, line 7, Col. 9, lines 53-Col. 10, lines 35, Col. 14, line 53-Col. 16, line 19. Applicants have reviewed *Nishikawa et al.*, and note that the only mention of

"searching" occurs in the last cited portion (Col. 14, line 53-Col. 16, line 19). Furthermore, searching is discussed only in the context of the electronic program guide (EPG) screen 650. Specifically, the portion of *Nishikawa et al.* relied on by the rejection discloses that

DSS processing element 200 generates an option palette 672 in EPG screen 650 if the user presses options key 312 on remote controller 14. Option palette 672 includes, but is not limited to, a "Search" icon 674, a "Category" icon 676, a "Calender" icon 678, and a "Guide Settings" icon 680. Preferably, highlight box (or cursor) 568 is positioned over "Search" icon 674 when option palette 672 is first displayed. If the user selects "Search" icon 674, DSS processing element 200 generates an on-screen keyboard, as discussed below (FIGS. 17-18).

(Col. 14, lines 53-62)

Referring now to FIG. 17, an on-screen keyboard 700...slides upwardly over option palette 672 and channel table 658 if the user selects "Search" icon 674 in option palette 672. On-screen keyboard 700 allows the user to search for a desired program by entering a search term (e.g., actor's name, sport team's name, movie director's name). On-screen keyboard 700 includes a plurality of keys 702 and a window 704 for displaying search terms entered by the user via keys 702. In operation, the user manipulates keys 702 of on-screen keyboard 700 via directional keys 318-324 and enter key 326 of remote controller 14. It should be noted that the user may enter search terms via keyboard peripheral 38 (FIG. 1) if keyboard peripheral 38 is connected to integrated DSS/WebTV receiver 12.

(Col. 15, lines 42-56)

A person of ordinary skill in the art would understand the search in *Nishikawa et al.* to be **searching the EPG** for programs matching a search term. Thus, even assuming that an EPG is a "device", *Nishikawa et al.* discloses at most searching a single device. In contrast, claim 117 recites "searching the **first and second storage devices** for media information having a high level of correlation with the search term". For at least these reasons, the rejection of claim 117 should be withdrawn.

B. Claim 132

Applicants respectfully submit that *Nishikawa et al.* fails to teach, disclose, or suggest at least the feature of a processor "configured to search in the memory device for the media information that corresponds to the first set of media programs and the second set of media programs and that has a high level of correlation with the search term" as recited in claim 132.

The Office Action (p. 7) indicates that claim 132 "is composed of the same structural elements were discussed with respect to the rejection of claim 117". Applicants disagree that

the scope of claim 132 and claim 117 are equivalent. However, Applicants will assume for the sake of argument that the rejection of claim 117 applies equally to claim 132.

As discussed above in connection with claim 117, the only search feature which Applicants could find in *Nishikawa et al.* searches **the EPG** for programs matching a search term. In contrast, claim 132 recites "search in the memory device for the media information that corresponds to the first set of media programs and the second set of media programs", where the first set of memory programs are programs recorded on a PVR. *Nishikawa et al.* does not explicitly disclose that a search of the EPG searches for already recorded programs, nor would a person of ordinary skill in the art understand an EPG to have this capability.

Furthermore, the search recited in claim 132 searches for media information that corresponds to programs on two different devices: the first set of programs is recorded on "a PVR" and the second set of programs is stored on "a recording device". *Nishikawa et al.* does not explicitly disclose that a search of the EPG searches for already recorded programs on two different devices, nor would a person of ordinary skill in the art understand an EPG to have this capability.

Finally, Applicants note that claim 132 further describes the memory device as being "in communication with a random access personal video recorder (PVR), the PVR configured to record a first set of media programs". *Nishikawa et al.* does not describe the EPG as being in communication with a recorder of any kind. For at least these reasons, the rejection of claim 132 should be withdrawn.

C. Claim 149

Applicants respectfully submit that *Nishikawa et al.* fails to teach, disclose, or suggest at least the feature of a processor "searching the memory for media information, corresponding to the first set of media programs and the second set of media programs, having a high level of correlation with the search term" as recited in claim 149.

The Office Action (p. 8) indicates that claim 149 "is composed of the same structural elements were discussed with respect to the rejection of claim 117". Applicants disagree that the scope of claim 149 and claim 117 are equivalent. However, Applicants will assume for the sake of argument that the rejection of claim 117 applies equally to claim 149.

As discussed above in connection with claim 117, the only search feature which Applicants could find in *Nishikawa et al.* searches **the EPG** for programs matching a search term. In contrast, claim 149 recites "searching the memory for media information, corresponding to the first set of media programs and the second set of media programs", where the first set of memory programs are programs associated with a PVR. *Nishikawa et al.* does not explicitly

disclose that a search of the EPG searches for programs associated with a PVR, nor would a person of ordinary skill in the art understand an EPG to have this capability. For at least these reasons, the rejection of claim 149 should be withdrawn.

D. Rejection of Dependent Claims 118-129, 133-146, and 150-160

Dependent claims 118-129, 133-146, and 150-160 have also been rejected under §102(e) as allegedly anticipated by, or, in the alternative, obvious over *Nishikawa et al.* (6,481,010). Independent claims 117, 132, and 149 are allowable for at least the reasons argued above. Since dependent claims 118-131, 133-148, and 150-160 incorporate the features of respective allowable claims 117, 132, and 149, dependent claims 118-131, 133-148, and 150-160 are allowable as a matter of law *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

II. Rejection of Claims 130-131, 147-148, and 162-163 under 35 U.S.C. §103

Claims 130-131, 147-148, and 162-163 have been rejected under §103(a) as allegedly obvious over *Nishikawa et al.* (6,481,010) in view of *Koshimuta* (6,515,710). Applicants respectfully submit that *Koshimuta* does not remedy the above-described deficiencies of *Nishikawa et al.* Since dependent claims 118-131, 147-148, and 150-160 incorporate the features of respective allowable claims 117, 132, and 149, dependent claims 130-131, 147-148, and 162-163 are allowable as a matter of law. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

III. Newly Added Claims

Applicant submits that new claim 164 is allowable over the cited references, for at least the reason that it depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests the Examiner to enter and allow the above new claims.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 117-128 and 130-164 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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